

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Grant HOOD et al.

Serial No.: 09/825, 412

Filed: April 3, 2001

For: Methods and Devices for Providing
Pooled Personal Introduction
ServicesThe Assistant Commissioner of Patents
Washington, D.C. 20231
U.S.A.

Dear Sir:

Group Art Unit: 2143

Examiner: Joseph E. AVELLINO

RECEIVED
CENTRAL FAX CENTER

MAR 21 2006

Certificate of Transmission	
I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office Fax No. (571) 273-8300 on <u>March 21, 2006</u> .	
Signature	<u>[Signature]</u>
<u>Matthew Zischka</u> Typed or printed name of person signing this certificate	

TRANSMITTAL OF APPEAL BRIEF (Small Entity)

Transmitted herewith in triplicate is the Appeal Brief in this application. The Notice of Appeal was filed on October 21, 2006

The fee for filing this Appeal Brief is: \$ 250.00

☐ A check in the amount of the fee is enclosed.

☒ Please charge Deposit Account No. 19-2548 in the amount of \$ 250.00.
A duplicate copy of this sheet is enclosed.

☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-2548. A duplicate copy of this sheet is enclosed.

☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application procession fees under 37 C.F.R. 1.17.

March 21, 2006

Date

92027-5

MZ/kew

Enclosures

Telephone: (416) 593-5514

Facsimile: (416) 591-1690

[Signature]
Matthew Zischka
Registration No. 41,575

SMART & BIGGAR
438 University Ave., Suite 1500
Toronto, Ontario, Canada M5G 2K8

03/22/2006 TL0111 00000041 192548 09825412

02 FC:2402

250.00 DA

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS**

In re the application of:)	
)	Group Art Unit: 2143
Grant HOOD et al.)	
)	Examiner: Joseph E. AVELLINO
Application No:09/825,412)	
)	Attorney Docket: 071235.0113
Filed: April 3, 2001)	
)	
For: Methods and Devices)	
For Providing Pooled)	
Personal Introduction)	
Services)	

APPELLANT'S BRIEF UNDER 37 C.F.R. 1.192

The Assistant Commissioner of Patents
Washington, D.C. 20231
U.S.A.

Dear Sir or Madam:

The following is the Appellant's Brief, submitted in triplicate and under the provisions of 37 C.F.R. 1.192. The fee of \$250 required by 37 C.F.R. 1.17(c) is enclosed.

Real Party in Interest

The real party in interest is the assignee of record, i.e. FIRST MEDIA GROUP INC., 536 Kipling Avenue, Etobicoke, Ontario, M8Z 5E3.

Related Appeals and Interferences

There are no related appeals or interferences that will directly affect, be directly affected by or have a bearing on the present appeal.

Application No. 09/825,412
Group Art Unit: 2143

- 2 -

Status of Claims

The present appeal is directed to claims 1-20, all of the pending claims in this application, all of which have been rejected.

Status of Amendments

No amendments have been filed after a final rejection.

Summary of the Invention

The invention relates to a method of facilitating exchange of messages at a computerized message exchange system. A first and second plurality of greetings are stored at the system. Each of the first plurality of greetings associated with users of a first introduction service provider. Each of the second plurality of greetings associated with a user of an introduction service provider, different from the first introduction service provider. Users associated with the first introduction service provider are allowed access to selected ones of the second plurality of greetings, based on criteria associated with an originator of each of the selected ones of the second greetings and criteria set by the first introduction service provider.

Users associated with the first introduction service provider may thus have access to greetings of users associated with other service providers, effectively increasing the number of persons to whom the users associated with the first introduction service provider may be introduced. Conveniently, access to greetings of various service providers and various users may be filtered, so that users of the first service provider only have access to users of selected other service providers, and to users having sanctioned interests.

Application No. 09/825,412
Group Art Unit: 2143

- 3 -

All this is may be transparent to end-users who need not realize that they have or do not have access to users of other service providers.

Issues

The issues at appeal are whether the Examiner erred in:

- A. rejecting independent claims 1 to 14 and 16 to 20 under 35 U.S.C. 103(a) in view of US Patent Publication 2002/0073343 to "Ziskind" et al. (hereinafter "Ziskind") and US Patent No. 6,665,3879 to "Haste" (hereinafter "Haste");
- B. rejecting dependent claim 15 under 35 U.S.C. 103(a) in view of Ziskind and Haste and US Patent No. 6,747,970 to Lamb.

Grouping of claims

Argument

A. Rejection of claims 1 to 14 and 16 to 20 under 35 U.S.C. 103(a) in view of Ziskind and Haste

Claims 1 to 14, and 16 to 20 remain rejected under 35 USC 103 as obvious in view of Ziskind and Haste.

In order to maintain a rejection under 35 USC 103, the Examiner must establish 1) presence of all the claim limitations in the prior art; 2) a motivation to modify or combine the elements in the prior art to arrive at the claimed invention; and 3) a likelihood of success.

Application No. 09/825,412
Group Art Unit: 2143

- 4 -

Careful review of Ziskind and Haste, reveal that neither Ziskind nor Haste disclose all of the elements in the currently pending claims (and in particular independent claims 1, 12 and 17), nor provide a motivation to modify or combine disclosed elements to arrive at the claimed invention. The Examiner has thus failed to establish a prima facie case of obviousness.

Specifically claim 1 claims,

Claim 1: A method of facilitating exchange of messages at a computerized message exchange system, comprising:

- storing a first plurality of greetings at said system, each of said first plurality of greetings associated with users of a first introduction service provider;
- storing a second plurality of greetings at said server, each of said second plurality of greetings associated with a user of an introduction service provider, different from said first introduction service provider;
- allowing users associated with said first introduction service provider, access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider.

Thus, as claimed, messages associated with users of two introduction service providers are stored and pooled so that users of at least one of the introduction service providers is provided access to selected greetings from users of the second introduction service provider. The selection is based on criteria associated with an originator of the second greetings and criteria set by the first introduction service provider.

Ziskind, however, is directed to a system allowing exchange of instant Internet messages. Instant messaging serves a fundamentally different purpose than introduction services, the subject of the present application. Instant messaging is designed to allow individuals, regardless of their specific interest, to communicate with each other. Thus, allowing users of one instant messaging service access to users of another is consistent with the underlying

Application No. 09/825,412
Group Art Unit: 2143

- 5 -

purpose of instant messaging, and is in principal no different than allowing subscribers of different phone companies to communicate with each other. As detailed in the background of the present application, introduction services are designed to introduce specific persons sharing a common interest, for, for example, social or dating purposes. As such, introduction service providers typically operate closed systems that only allow limited access between subscribers. A person of ordinary skill would thus have no motivation to use instant messaging systems and modify them to arrive at an introduction service, as suggested by the Examiner.

More fundamentally, however, even if Ziskind and Haste were combined, a person of ordinary skill would not arrive at the claimed invention, as neither Ziskind nor Haste disclose all of the elements of independent claims 1, 12 or 17.

As claimed in claim 1,

"users associated with said first introduction service provider, access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider."

That is, users of a first introduction service provider are given access to greetings of selected users of a second service provider. The selection is based on criteria associated with the originators of each of the second greetings, and criteria set by the first service provider. In this way, the effective number of users whose greetings are apparently available to users of the first service provider is increased, by pooling greetings of users of the first and second service providers. At the same time sensitivities of the users of the first service provider, and the service provider itself are respected, by selecting which greetings of which users of the second service provider access are provided based on the originator of each of the second greetings, and criteria set by the first service provider. Example criteria used by the first service

Application No. 09/825,412
Group Art Unit: 2143

- 6 -

provider include the gender, age and interest of users of the second service provider.

This is neither disclosed nor suggested by Ziskind or Haste.

In response to this argument, the Examiner refers to paragraph [0032] of Ziskind. Paragraph [0032] merely discloses the format of login data exchanged in Ziskind.

As noted in paragraph [0032] of Ziskind

[0032] Referring to FIG. 2, the method of the present invention includes the steps as follows. A user of an affiliate Web site logs into that site's Web services, step 10, with the user's client computer, creating a connection between the Internet and the client computer from which the user can invoke the Bantu Messenger. The affiliate user launches the Bantu Messenger by clicking on a link. Upon launching the Bantu Messenger, a login request is made to the Bantu Web server via a document.form.submit function which is located on the affiliate site. This function submits a hidden form to Bantu.com requesting Bantu messenger services and includes customization information, such as default language. Bantu in turn queries a senduser script located on the affiliate Web server. The exact URL for this script is supplied to the messenger service provider by the affiliate site. In addition, the senduser script can also be protected by IP block and by a username and password. The affiliate database is searched for the user's id and password. An XML formatted data packet is returned to the Bantu Web server with verification information 12. The XML data packet of this preferred embodiment contains the following fields:

...

Language 3 4 = Language 4 5 = Language 5 6 = Language 6
ContactEmailAddress A valid email address (for contact purposes) (max length 200 characters). [optional] ContactUserPref Single characters of ether B, N, or A Current Values: B = contact via. bantu.com mail A = contact via. contact e-mail Address N = never contact LocationZipCode User's zip code in the format of ##### or #####-####. Only for U.S. zipcodes. [optional] LocationCity User's city (max length 50 characters). [optional] LocationState User's state (max length 50 characters). [optional] LocationCountry User's country (2 char ISO country code).

Application No. 09/825,412
Group Art Unit: 2143

- 7 -

[optional] gender User's gender (single char of either M or F or X). Use value "X" if gender is unknown. birthDate User's birth date in MM/DD/YYYY format. [optional] birthYear User's birth year (4 digit year). listingInUserDirectory Public directory list flag (numeric 1 or 0). Set to "1" if the user should appear in listings of users who are online, or set to "0" is this is not desired. (Emphasis Added)

Ziskind thus alludes to the possibility of having a directory, but goes no further. As previously pointed out, the present application involves far more than a mere directory.

In the final action mailed April 21, the Examiner goes so far as to admit that the claim elements are not in the prior art. Nevertheless, relying on paragraph [0032] of Ziskind, the Examiner reasons "all of these fields are included for all service providers and thereby give motivation in order to search for a selected sub-set of users of other service providers. This gives proper motivation to find other systems which search for users based on selected criteria eventually finding the system of Haste and its interactive Internet based dating service providing a search service including age, location, physical characteristics, interests and lifestyles (see FIG. 1C)" (emphasis added). So, using the Examiner's reasoning, the mere presence of fields that could be used for filtering would eventually lead a person of ordinary skill to arrive at the missing limitation allowing users associated with the first introduction service provider, access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider.

This, it is submitted, is simply not the legal test for obviousness under 35 USC 103. To establish a *prima facie* case, all claim elements must first be found in the art, and there must be a motivation to combine/modify to arrive at the invention. The mere presence of a subset of the elements in the art, and knowledge of the applicants' invention is simply insufficient to conclude that a person of ordinary skill would arrive at the remaining claim elements and the

Application No. 09/825,412
Group Art Unit: 2143

- 8 -

invention. Any such, the conclusion reached by Examiner does not appear to be based on the cited art but instead appears to be made with impermissible hindsight.

Independent claims 12 and 17 similarly claim message exchange systems and computer readable memories including or storing software allowing users associated with said first service provider, access to a selected one of said second plurality of greetings, based on criteria associated with an originator of said selected one of said second greetings, and criteria set by said first service provider. For the reasons set out above, this limitation is simply not disclosed nor suggested by Haste or Ziskind.

Reversal of the rejection of independent claims 1, 12 and 17 and claims 13, 14, 2 to 11, 16, 18 to 20 dependent thereon is therefore required.

**B. Restriction of claim 15 under 35 USC 103(a) in view of Ziskind
Haste or Lamb**

Claim 15 remains rejected under 35 USC 103(a) in view of Ziskind, Haste and Lamb.

Claim 15 depends from independent claim 12.

For the reasons set out above, claim 12 is simply not obvious in view of Ziskind, or Haste. Lamb similarly fails to address the deficiencies of Ziskind and Haste identified above. That is, neither Ziskind, Haste nor Lamb disclose all the limitations of claim 12 (and therefore claim 15) nor provide a motivation to combine or modify these references to arrive at the invention of claim 15.

Reversal of the rejection of dependent claim 15 is therefore required.

Application No. 09/825,412
Group Art Unit: 2143

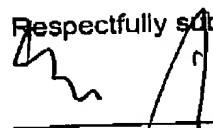
- 9 -

Summary

For the foregoing reasons, it is submitted that the Examiner's rejection of claims 1-20 is erroneous, and reversal of his rejections is respectfully requested.

Respectfully submitted,

By


Matthew Zischka
Registration No. 41,575

SMART & BIGGAR
438 University Avenue
Suite 1500, Box 111
Toronto, Ontario
M5G 2K8

Telephone: (416) 593-5514
Facsimile: (416) 591-1690

Date: March 21, 2006
92027-5
MZ/kew
Enclosures

Application No. 09/386,641
Group Art Unit: 3623

- 10 -

Appendix – Claims Currently on File

1. (original) A method of facilitating exchange of messages at a computerized message exchange system, comprising:
 - storing a first plurality of greetings at said system, each of said first plurality of greetings associated with users of a first introduction service provider;
 - storing a second plurality of greetings at said server, each of said second plurality of greetings associated with a user of an introduction service provider, different from said first introduction service provider;
 - allowing users associated with said first introduction service provider, access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider.
2. (original) The method of claim 1 wherein
 - said allowing limits said second plurality of greetings to greetings associated with users of introduction service providers authorized by said first introduction service provider.
3. (original) The method of claim 2, wherein
 - said allowing limits said second plurality of greetings to greetings associated with users having interests sanctioned by said first introduction service provider.
4. (original) The method of claim 2, wherein
 - said allowing comprises using data stored within a first field at said server, and associated with said first service provider, to determine users of which other service providers are authorized by said first introduction service provider.

Application No. 09/386,641
Group Art Unit: 3623

- 11 -

5. (original) The method of claim 4, wherein
said allowing comprises using data stored in a second field at said server,
and associated with said first service provider, to determine said interests
that are sanctioned by said first introduction service provider.
6. (original) The method of claim 5 wherein said allowing comprises
generating a database query, and querying a database of user records to
extract said selected ones of said second plurality of greetings.
7. (original) The method of claim 6 wherein said first field contains a binary
mask.
8. (original) The method of claim 7 wherein said second field contains a binary
mask.
9. (original) The method of claim 7, wherein said allowing comprises determining
service provider identifiers corresponding to said binary mask in said first
field.
10. (original) The method of claim 1, further comprising permitting a user of said
first service provider to send a message to said users associated with said
selected ones of said second plurality of greetings.
11. (original) The method of claim 10, further comprising levying a charge for
sending said message, and tallying a total of charges for users associated
with said first service provider.
12. (original) A message exchange system, comprising computer readable
memory storing,:

Application No. 09/386,641
Group Art Unit: 3623

- 12 -

a first plurality of greetings, each of said first plurality of greetings associated with users of a first introduction service;
a second plurality of greetings, each of said second plurality of greetings associated with a user of an introduction service, different from said first introduction service;
software allowing users associated with said first service provider, access to a selected one of said second plurality of greetings, based on criteria associated with an originator of said selected one of said second greetings, and criteria set by said first service provider.

13. (original) The system of claim 12, further comprising a database storing records associated with each of said users associated with said first service provider.
14. (original) The system of claim 13, wherein said software generates database queries, and queries said database to extract said selected ones of said second plurality of greetings.
15. (original) The system of claim 12, further comprising an interactive voice response ("IVR") unit, for obtaining instructions from said user by way of a telephone network.
16. (original) The system of claim 12, further comprising a network data interactive for obtaining instructions from said user by way of a data network.
17. (original) Computer readable medium, storing processor executable instructions, that when loaded at computerized message exchange system comprising a processor, adapt said computerized message exchange system to:

Application No. 09/386,641
Group Art Unit: 3623

- 13 -

store a first plurality of greetings at said system, each of said first plurality of greetings associated with users of a first introduction service provider;
store a second plurality of greetings at said server, each of said second plurality of greetings associated with a user of an introduction service provider, different from said first introduction service provider;
allow users associated with said first introduction service provider access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider.

18. (previously presented) The method of Claim 1, wherein said criteria comprise at least one of interest, age, and gender of said originator of each of said selected ones of said second greetings.
19. (previously presented) The system of Claim 12, wherein said criteria comprise at least one of interest, age, and gender of said originator of each of said selected ones of said second greetings.
20. (previously presented) The system of Claim 17, wherein said criteria comprise at least one of interest, age, and gender of said originator of each of said selected ones of said second greetings.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS**

In re the application of:)	Group Art Unit: 2143
Grant HOOD et al.)	Examiner: Joseph E. AVELLINO
Application No:09/825,412)	Attorney Docket: 071235.0113
Filed: April 3, 2001)	
For: Methods and Devices)	
For Providing Pooled)	
Personal Introduction)	
Services)	

APPELLANT'S BRIEF UNDER 37 C.F.R. 1.192

The Assistant Commissioner of Patents
Washington, D.C. 20231
U.S.A.

Dear Sir or Madam:

The following is the Appellant's Brief, submitted in triplicate and under the provisions of 37 C.F.R. 1.192. The fee of \$250 required by 37 C.F.R. 1.17(c) is enclosed.

Real Party in Interest

The real party in interest is the assignee of record, i.e. FIRST MEDIA GROUP INC., 536 Kipling Avenue, Etobicoke, Ontario, M8Z 5E3.

Related Appeals and Interferences

There are no related appeals or interferences that will directly affect, be directly affected by or have a bearing on the present appeal.

Application No. 09/825,412
Group Art Unit: 2143

- 2 -

Status of Claims

The present appeal is directed to claims 1-20, all of the pending claims in this application, all of which have been rejected.

Status of Amendments

No amendments have been filed after a final rejection.

Summary of the Invention

The invention relates to a method of facilitating exchange of messages at a computerized message exchange system. A first and second plurality of greetings are stored at the system. Each of the first plurality of greetings associated with users of a first introduction service provider. Each of the second plurality of greetings associated with a user of an introduction service provider, different from the first introduction service provider. Users associated with the first introduction service provider are allowed access to selected ones of the second plurality of greetings, based on criteria associated with an originator of each of the selected ones of the second greetings and criteria set by the first introduction service provider.

Users associated with the first introduction service provider may thus have access to greetings of users associated with other service providers, effectively increasing the number of persons to whom the users associated with the first introduction service provider may be introduced. Conveniently, access to greetings of various service providers and various users may be filtered, so that users of the first service provider only have access to users of selected other service providers, and to users having sanctioned interests.

Application No. 09/825,412
Group Art Unit: 2143

- 3 -

All this is may be transparent to end-users who need not realize that they have or do not have access to users of other service providers.

Issues

The issues at appeal are whether the Examiner erred in:

- A. rejecting independent claims 1 to 14 and 16 to 20 under 35 U.S.C. 103(a) in view of US Patent Publication 2002/0073343 to "Ziskind" et al. (hereinafter "Ziskind") and US Patent No. 6,665,3879 to "Haste" (hereinafter "Haste");
- B. rejecting dependent claim 15 under 35 U.S.C. 103(a) in view of Ziskind and Haste and US Patent No. 6,747,970 to Lamb.

Grouping of claims

Argument

A. Rejection of claims 1 to 14 and 16 to 20 under 35 U.S.C. 103(a) in view of Ziskind and Haste

Claims 1 to 14, and 16 to 20 remain rejected under 35 USC 103 as obvious in view of Ziskind and Haste.

In order to maintain a rejection under 35 USC 103, the Examiner must establish 1) presence of all the claim limitations in the prior art; 2) a motivation to modify or combine the elements in the prior art to arrive at the claimed invention; and 3) a likelihood of success.

Application No. 09/825,412
Group Art Unit: 2143

- 4 -

Careful review of Ziskind and Haste, reveal that neither Ziskind nor Haste disclose all of the elements in the currently pending claims (and in particular independent claims 1, 12 and 17), nor provide a motivation to modify or combine disclosed elements to arrive at the claimed invention. The Examiner has thus failed to establish a prima facie case of obviousness.

Specifically claim 1 claims,

Claim 1: A method of facilitating exchange of messages at a computerized message exchange system, comprising:

- storing a first plurality of greetings at said system, each of said first plurality of greetings associated with users of a first introduction service provider;
- storing a second plurality of greetings at said server, each of said second plurality of greetings associated with a user of an introduction service provider, different from said first introduction service provider;
- allowing users associated with said first introduction service provider, access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider.

Thus, as claimed, messages associated with users of two introduction service providers are stored and pooled so that users of at least one of the introduction service providers is provided access to selected greetings from users of the second introduction service provider. The selection is based on criteria associated with an originator of the second greetings and criteria set by the first introduction service provider.

Ziskind, however, is directed to a system allowing exchange of instant Internet messages. Instant messaging serves a fundamentally different purpose than introduction services, the subject of the present application. Instant messaging is designed to allow individuals, regardless of their specific interest, to communicate with each other. Thus, allowing users of one instant messaging service access to users of another is consistent with the underlying

Application No. 09/825,412
Group Art Unit: 2143

- 5 -

purpose of instant messaging, and is in principal no different than allowing subscribers of different phone companies to communicate with each other. As detailed in the background of the present application, introduction services are designed to introduce specific persons sharing a common interest, for, for example, social or dating purposes. As such, introduction service providers typically operate closed systems that only allow limited access between subscribers. A person of ordinary skill would thus have no motivation to use instant messaging systems and modify them to arrive at an introduction service, as suggested by the Examiner.

More fundamentally, however, even if Ziskind and Haste were combined, a person of ordinary skill would not arrive at the claimed invention, as neither Ziskind nor Haste disclose all of the elements of independent claims 1, 12 or 17.

As claimed in claim 1,

"users associated with said first introduction service provider, access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider."

That is, users of a first introduction service provider are given access to greetings of selected users of a second service provider. The selection is based on criteria associated with the originators of each of the second greetings, and criteria set by the first service provider. In this way, the effective number of users whose greetings are apparently available to users of the first service provider is increased, by pooling greetings of users of the first and second service providers. At the same time sensitivities of the users of the first service provider, and the service provider itself are respected, by selecting which greetings of which users of the second service provider access are provided based on the originator of each of the second greetings, and criteria set by the first service provider. Example criteria used by the first service

Application No. 09/825,412
Group Art Unit: 2143

- 6 -

provider include the gender, age and interest of users of the second service provider.

This is neither disclosed nor suggested by Ziskind or Haste.

In response to this argument, the Examiner refers to paragraph [0032] of Ziskind. Paragraph [0032] merely discloses the format of login data exchanged in Ziskind.

As noted in paragraph [0032] of Ziskind

[0032] Referring to FIG. 2, the method of the present invention includes the steps as follows. A user of an affiliate Web site logs into that site's Web services, step 10, with the user's client computer, creating a connection between the Internet and the client computer from which the user can invoke the Bantu Messenger. The affiliate user launches the Bantu Messenger by clicking on a link. Upon launching the Bantu Messenger, a login request is made to the Bantu Web server via a document.form.submit function which is located on the affiliate site. This function submits a hidden form to Bantu.com requesting Bantu messenger services and includes customization information, such as default language. Bantu in turn queries a sender script located on the affiliate Web server. The exact URL for this script is supplied to the messenger service provider by the affiliate site. In addition, the sender script can also be protected by IP block and by a username and password. The affiliate database is searched for the user's id and password. An XML formatted data packet is returned to the Bantu Web server with verification information 12. The XML data packet of this preferred embodiment contains the following fields:

...

Language 3 4 = Language 4 5 = Language 5 6 = Language 6
ContactEmailAddress A valid email address (for contact purposes) (max length 200 characters). [optional] ContactUserPref Single characters of ether B, N, or A Current Values: B = contact via. bantu.com mail A = contact via. contact e-mail Address N = never contact LocationZipCode User's zip code in the format of ##### or #####-####. Only for U.S. zipcodes. [optional] LocationCity User's city (max length 50 characters). [optional] LocationState User's state (max length 50 characters). [optional] LocationCountry User's country (2 char ISO country code).

Application No. 09/825,412
Group Art Unit: 2143

- 7 -

[optional] gender User's gender (single char of either M or F or X). Use value "X" if gender is unknown. birthDate User's birth date in MM/DD/YYYY format. [optional] birthYear User's birth year (4 digit year). listingInUserDirectory Public directory list flag (numeric 1 or 0). Set to "1" if the user should appear in listings of users who are online, or set to "0" is this is not desired. (Emphasis Added)

Ziskind thus alludes to the possibility of having a directory, but goes no further. As previously pointed out, the present application involves far more than a mere directory.

In the final action mailed April 21, the Examiner goes so far as to admit that the claim elements are not in the prior art. Nevertheless, relying on paragraph [0032] of Ziskind, the Examiner reasons "all of these fields are included for all service providers and thereby give motivation in order to search for a selected sub-set of users of other service providers. This gives proper motivation to find other systems which search for users based on selected criteria eventually finding the system of Haste and its interactive Internet based dating service providing a search service including age, location, physical characteristics, interests and lifestyles (see FIG. 1C)" (emphasis added). So, using the Examiner's reasoning, the mere presence of fields that could be used for filtering would eventually lead a person of ordinary skill to arrive at the missing limitation allowing users associated with the first introduction service provider, access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider.

This, it is submitted, is simply not the legal test for obviousness under 35 USC 103. To establish a *prima facie* case, all claim elements must first be found in the art, and there must be a motivation to combine/modify to arrive at the invention. The mere presence of a subset of the elements in the art, and knowledge of the applicants' invention is simply insufficient to conclude that a person of ordinary skill would arrive at the remaining claim elements and the

Application No. 09/825,412 - 8 -
Group Art Unit: 2143

invention. Any such, the conclusion reached by Examiner does not appear to be based on the cited art but instead appears to be made with impermissible hindsight.

Independent claims 12 and 17 similarly claim message exchange systems and computer readable memories including or storing software allowing users associated with said first service provider, access to a selected one of said second plurality of greetings, based on criteria associated with an originator of said selected one of said second greetings, and criteria set by said first service provider. For the reasons set out above, this limitation is simply not disclosed nor suggested by Haste or Ziskind.

Reversal of the rejection of independent claims 1, 12 and 17 and claims 13, 14, 2 to 11, 16, 18 to 20 dependent thereon is therefore required.

**B. Restriction of claim 15 under 35 USC 103(a) in view of Ziskind
Haste or Lamb**

Claim 15 remains rejected under 35 USC 103(a) in view of Ziskind,
Haste and Lamb.

Claim 15 depends from independent claim 12.

For the reasons set out above, claim 12 is simply not obvious in view of Ziskind, or Haste. Lamb similarly fails to address the deficiencies of Ziskind and Haste identified above. That is, neither Ziskind, Haste nor Lamb disclose all the limitations of claim 12 (and therefore claim 15) nor provide a motivation to combine or modify these references to arrive at the invention of claim 15.

Reversal of the rejection of dependent claim 15 is therefore required.

Application No. 09/825,412
Group Art Unit: 2143

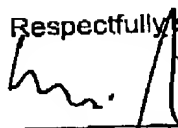
- 9 -

Summary

For the foregoing reasons, it is submitted that the Examiner's rejection of claims 1-20 is erroneous, and reversal of his rejections is respectfully requested.

Respectfully submitted,

By


Matthew Zischka
Registration No. 41,575

SMART & BIGGAR
438 University Avenue
Suite 1500, Box 111
Toronto, Ontario
M5G 2K8

Telephone: (416) 593-5514
Facsimile: (416) 591-1690

Date: March 21, 2006
92027-5
MZ/kew
Enclosures

Application No. 09/386,641
Group Art Unit: 3623

- 10 -

Appendix – Claims Currently on File

1. (original) A method of facilitating exchange of messages at a computerized message exchange system, comprising:
 - storing a first plurality of greetings at said system, each of said first plurality of greetings associated with users of a first introduction service provider;
 - storing a second plurality of greetings at said server, each of said second plurality of greetings associated with a user of an introduction service provider, different from said first introduction service provider;
 - allowing users associated with said first introduction service provider, access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider.
2. (original) The method of claim 1 wherein
 - said allowing limits said second plurality of greetings to greetings associated with users of introduction service providers authorized by said first introduction service provider.
3. (original) The method of claim 2, wherein
 - said allowing limits said second plurality of greetings to greetings associated with users having interests sanctioned by said first introduction service provider.
4. (original) The method of claim 2, wherein
 - said allowing comprises using data stored within a first field at said server, and associated with said first service provider, to determine users of which other service providers are authorized by said first introduction service provider.

Application No. 09/386,641
Group Art Unit: 3623

- 11 -

5. (original) The method of claim 4, wherein
said allowing comprises using data stored in a second field at said server,
and associated with said first service provider, to determine said interests
that are sanctioned by said first introduction service provider.
6. (original) The method of claim 5 wherein said allowing comprises
generating a database query, and querying a database of user records to
extract said selected ones of said second plurality of greetings.
7. (original) The method of claim 6 wherein said first field contains a binary
mask.
8. (original) The method of claim 7 wherein said second field contains a binary
mask.
9. (original) The method of claim 7, wherein said allowing comprises determining
service provider identifiers corresponding to said binary mask in said first
field.
10. (original) The method of claim 1, further comprising permitting a user of said
first service provider to send a message to said users associated with said
selected ones of said second plurality of greetings.
11. (original) The method of claim 10, further comprising levying a charge for
sending said message, and tallying a total of charges for users associated
with said first service provider.
12. (original) A message exchange system, comprising computer readable
memory storing,:

Application No. 09/386,641
Group Art Unit: 3623

- 12 -

a first plurality of greetings, each of said first plurality of greetings associated with users of a first introduction service;
a second plurality of greetings, each of said second plurality of greetings associated with a user of an introduction service, different from said first introduction service;
software allowing users associated with said first service provider, access to a selected one of said second plurality of greetings, based on criteria associated with an originator of said selected one of said second greetings, and criteria set by said first service provider.

13. (original) The system of claim 12, further comprising a database storing records associated with each of said users associated with said first service provider.

14. (original) The system of claim 13, wherein said software generates database queries, and queries said database to extract said selected ones of said second plurality of greetings.

15. (original) The system of claim 12, further comprising an interactive voice response ("IVR") unit, for obtaining instructions from said user by way of a telephone network.

16. (original) The system of claim 12, further comprising a network data interactive for obtaining instructions from said user by way of a data network.

17. (original) Computer readable medium, storing processor executable instructions, that when loaded at computerized message exchange system comprising a processor, adapt said computerized message exchange system to:

Application No. 09/386,641
Group Art Unit: 3623

- 13 -

store a first plurality of greetings at said system, each of said first plurality of greetings associated with users of a first introduction service provider;
store a second plurality of greetings at said server, each of said second plurality of greetings associated with a user of an introduction service provider, different from said first introduction service provider;
allow users associated with said first introduction service provider access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider.

18. (previously presented) The method of Claim 1, wherein said criteria comprise at least one of interest, age, and gender of said originator of each of said selected ones of said second greetings.
19. (previously presented) The system of Claim 12, wherein said criteria comprise at least one of interest, age, and gender of said originator of each of said selected ones of said second greetings.
20. (previously presented) The system of Claim 17, wherein said criteria comprise at least one of interest, age, and gender of said originator of each of said selected ones of said second greetings.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS**

In re the application of:)	
)	Group Art Unit: 2143
Grant HOOD et al.)	
)	Examiner: Joseph E. AVELLINO
Application No:09/825,412)	
)	Attorney Docket: 071235.0113
Filed: April 3, 2001)	
)	
For: Methods and Devices)	
For Providing Pooled)	
Personal Introduction)	
Services)	

APPELLANT'S BRIEF UNDER 37 C.F.R. 1.192

The Assistant Commissioner of Patents
Washington, D.C. 20231
U.S.A.

Dear Sir or Madam:

The following is the Appellant's Brief, submitted in triplicate and under the provisions of 37 C.F.R. 1.192. The fee of \$250 required by 37 C.F.R. 1.17(c) is enclosed.

Real Party in Interest

The real party in interest is the assignee of record, i.e. FIRST MEDIA GROUP INC., 536 Kipling Avenue, Etobicoke, Ontario, M8Z 5E3.

Related Appeals and Interferences

There are no related appeals or interferences that will directly affect, be directly affected by or have a bearing on the present appeal.

Application No. 09/825,412
Group Art Unit: 2143

- 2 -

Status of Claims

The present appeal is directed to claims 1-20, all of the pending claims in this application, all of which have been rejected.

Status of Amendments

No amendments have been filed after a final rejection.

Summary of the Invention

The invention relates to a method of facilitating exchange of messages at a computerized message exchange system. A first and second plurality of greetings are stored at the system. Each of the first plurality of greetings associated with users of a first introduction service provider. Each of the second plurality of greetings associated with a user of an introduction service provider, different from the first introduction service provider. Users associated with the first introduction service provider are allowed access to selected ones of the second plurality of greetings, based on criteria associated with an originator of each of the selected ones of the second greetings and criteria set by the first introduction service provider.

Users associated with the first introduction service provider may thus have access to greetings of users associated with other service providers, effectively increasing the number of persons to whom the users associated with the first introduction service provider may be introduced. Conveniently, access to greetings of various service providers and various users may be filtered, so that users of the first service provider only have access to users of selected other service providers, and to users having sanctioned interests.

Application No. 09/825,412
Group Art Unit: 2143

- 3 -

All this is may be transparent to end-users who need not realize that they have or do not have access to users of other service providers.

Issues

The issues at appeal are whether the Examiner erred in:

- A. rejecting independent claims 1 to 14 and 16 to 20 under 35 U.S.C. 103(a) in view of US Patent Publication 2002/0073343 to "Ziskind" et al. (hereinafter "Ziskind") and US Patent No. 6,665,3879 to "Haste" (hereinafter "Haste");
- B. rejecting dependent claim 15 under 35 U.S.C. 103(a) in view of Ziskind and Haste and US Patent No. 6,747,970 to Lamb.

Grouping of claims

Argument

A. Rejection of claims 1 to 14 and 16 to 20 under 35 U.S.C. 103(a) in view of Ziskind and Haste

Claims 1 to 14, and 16 to 20 remain rejected under 35 USC 103 as obvious in view of Ziskind and Haste.

In order to maintain a rejection under 35 USC 103, the Examiner must establish 1) presence of all the claim limitations in the prior art; 2) a motivation to modify or combine the elements in the prior art to arrive at the claimed invention; and 3) a likelihood of success.

Application No. 09/825,412
Group Art Unit: 2143

- 4 -

Careful review of Ziskind and Haste, reveal that neither Ziskind nor Haste disclose all of the elements in the currently pending claims (and in particular independent claims 1, 12 and 17), nor provide a motivation to modify or combine disclosed elements to arrive at the claimed invention. The Examiner has thus failed to establish a prima facie case of obviousness.

Specifically claim 1 claims,

Claim 1: A method of facilitating exchange of messages at a computerized message exchange system, comprising:

- storing a first plurality of greetings at said system, each of said first plurality of greetings associated with users of a first introduction service provider;
- storing a second plurality of greetings at said server, each of said second plurality of greetings associated with a user of an introduction service provider, different from said first introduction service provider;
- allowing users associated with said first introduction service provider, access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider.

Thus, as claimed, messages associated with users of two introduction service providers are stored and pooled so that users of at least one of the introduction service providers is provided access to selected greetings from users of the second introduction service provider. The selection is based on criteria associated with an originator of the second greetings and criteria set by the first introduction service provider.

Ziskind, however, is directed to a system allowing exchange of instant Internet messages. Instant messaging serves a fundamentally different purpose than introduction services, the subject of the present application. Instant messaging is designed to allow individuals, regardless of their specific interest, to communicate with each other. Thus, allowing users of one instant messaging service access to users of another is consistent with the underlying

Application No. 09/825,412
Group Art Unit: 2143

- 5 -

purpose of instant messaging, and is in principal no different than allowing subscribers of different phone companies to communicate with each other. As detailed in the background of the present application, introduction services are designed to introduce specific persons sharing a common interest, for, for example, social or dating purposes. As such, introduction service providers typically operate closed systems that only allow limited access between subscribers. A person of ordinary skill would thus have no motivation to use instant messaging systems and modify them to arrive at an introduction service, as suggested by the Examiner.

More fundamentally, however, even if Ziskind and Haste were combined, a person of ordinary skill would not arrive at the claimed invention, as neither Ziskind nor Haste disclose all of the elements of independent claims 1, 12 or 17.

As claimed in claim 1,

"users associated with said first introduction service provider, access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider."

That is, users of a first introduction service provider are given access to greetings of selected users of a second service provider. The selection is based on criteria associated with the originators of each of the second greetings, and criteria set by the first service provider. In this way, the effective number of users whose greetings are apparently available to users of the first service provider is increased, by pooling greetings of users of the first and second service providers. At the same time sensitivities of the users of the first service provider, and the service provider itself are respected, by selecting which greetings of which users of the second service provider access are provided based on the originator of each of the second greetings, and criteria set by the first service provider. Example criteria used by the first service

Application No. 09/825,412 - 6 -
Group Art Unit: 2143

provider include the gender, age and interest of users of the second service provider.

This is neither disclosed nor suggested by Ziskind or Haste.

In response to this argument, the Examiner refers to paragraph [0032] of Ziskind. Paragraph [0032] merely discloses the format of login data exchanged in Ziskind.

As noted in paragraph [0032] of Ziskind

[0032] Referring to FIG. 2, the method of the present invention includes the steps as follows. A user of an affiliate Web site logs into that site's Web services, step 10, with the user's client computer, creating a connection between the Internet and the client computer from which the user can invoke the Bantu Messenger. The affiliate user launches the Bantu Messenger by clicking on a link. Upon launching the Bantu Messenger, a login request is made to the Bantu Web server via a document.form.submit function which is located on the affiliate site. This function submits a hidden form to Bantu.com requesting Bantu messenger services and includes customization information, such as default language. Bantu in turn queries a sender script located on the affiliate Web server. The exact URL for this script is supplied to the messenger service provider by the affiliate site. In addition, the sender script can also be protected by IP block and by a username and password. The affiliate database is searched for the user's id and password. An XML formatted data packet is returned to the Bantu Web server with verification information 12. The XML data packet of this preferred embodiment contains the following fields:

...

Language 3 4 = Language 4 5 = Language 5 6 = Language 6
ContactEmailAddress A valid email address (for contact purposes) (max length 200 characters). [optional] ContactUserPref Single characters of either B, N, or A Current Values: B = contact via. bantu.com mail A = contact via. contact e-mail Address N = never contact LocationZipCode User's zip code in the format of ##### or #####-####. Only for U.S. zipcodes. [optional] LocationCity User's city (max length 50 characters). [optional] LocationState User's state (max length 50 characters). [optional] LocationCountry User's country (2 char ISO country code).

Application No. 09/825,412
Group Art Unit: 2143

- 7 -

[optional] gender User's gender (single char of either M or F or X). Use value "X" if gender is unknown. birthDate User's birth date in MM/DD/YYYY format. [optional] birthYear User's birth year (4 digit year). listingInUserDirectory **Public directory list flag (numeric 1 or 0). Set to "1" if the user should appear in listings of users who are online, or set to "0" is this is not desired.** (Emphasis Added)

Ziskind thus alludes to the possibility of having a directory, but goes no further. As previously pointed out, the present application involves far more than a mere directory.

In the final action mailed April 21, the Examiner goes so far as to admit that the claim elements are not in the prior art. Nevertheless, relying on paragraph [0032] of Ziskind, the Examiner reasons "all of these fields are included for all service providers and thereby give motivation in order to search for a selected sub-set of users of other service providers. This gives proper motivation to find other systems which search for users based on selected criteria eventually finding the system of Haste and its interactive Internet based dating service providing a search service including age, location, physical characteristics, interests and lifestyles (see FIG. 1C)" (emphasis added). So, using the Examiner's reasoning, the mere presence of fields that could be used for filtering would eventually lead a person of ordinary skill to arrive at the missing limitation allowing users associated with the first introduction service provider, access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider.

This, it is submitted, is simply not the legal test for obviousness under 35 USC 103. To establish a *prima facie* case, all claim elements must first be found in the art, and there must be a motivation to combine/modify to arrive at the invention. The mere presence of a subset of the elements in the art, and knowledge of the applicants' invention is simply insufficient to conclude that a person of ordinary skill would arrive at the remaining claim elements and the

Application No. 09/825,412 - 8 -
Group Art Unit: 2143

invention. Any such, the conclusion reached by Examiner does not appear to be based on the cited art but instead appears to be made with impermissible hindsight.

Independent claims 12 and 17 similarly claim message exchange systems and computer readable memories including or storing software allowing users associated with said first service provider, access to a selected one of said second plurality of greetings, based on criteria associated with an originator of said selected one of said second greetings, and criteria set by said first service provider. For the reasons set out above, this limitation is simply not disclosed nor suggested by Haste or Ziskind.

Reversal of the rejection of independent claims 1, 12 and 17 and claims 13, 14, 2 to 11, 16, 18 to 20 dependent thereon is therefore required.

**B. Restriction of claim 15 under 35 USC 103(a) in view of Ziskind
Haste or Lamb**

Claim 15 remains rejected under 35 USC 103(a) in view of Ziskind, Haste and Lamb.

Claim 15 depends from independent claim 12.

For the reasons set out above, claim 12 is simply not obvious in view of Ziskind, or Haste. Lamb similarly fails to address the deficiencies of Ziskind and Haste identified above. That is, neither Ziskind, Haste nor Lamb disclose all the limitations of claim 12 (and therefore claim 15) nor provide a motivation to combine or modify these references to arrive at the invention of claim 15.

Reversal of the rejection of dependent claim 15 is therefore required.

Application No. 09/825,412
Group Art Unit: 2143

- 9 -

Summary

For the foregoing reasons, it is submitted that the Examiner's rejection of claims 1-20 is erroneous, and reversal of his rejections is respectfully requested.

Respectfully submitted,

By


Matthew Zischka
Registration No. 41,575

SMART & BIGGAR
438 University Avenue
Suite 1500, Box 111
Toronto, Ontario
M5G 2K8

Telephone: (416) 593-5514
Facsimile: (416) 591-1690

Date: March 21, 2006
92027-5
MZ/kew
Enclosures

Application No. 09/386,641
Group Art Unit: 3623

- 10 -

Appendix – Claims Currently on File

1. (original) A method of facilitating exchange of messages at a computerized message exchange system, comprising:
 - storing a first plurality of greetings at said system, each of said first plurality of greetings associated with users of a first introduction service provider;
 - storing a second plurality of greetings at said server, each of said second plurality of greetings associated with a user of an introduction service provider, different from said first introduction service provider;
 - allowing users associated with said first introduction service provider, access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider.
2. (original) The method of claim 1 wherein
 - said allowing limits said second plurality of greetings to greetings associated with users of introduction service providers authorized by said first introduction service provider.
3. (original) The method of claim 2, wherein
 - said allowing limits said second plurality of greetings to greetings associated with users having interests sanctioned by said first introduction service provider.
4. (original) The method of claim 2, wherein
 - said allowing comprises using data stored within a first field at said server, and associated with said first service provider, to determine users of which other service providers are authorized by said first introduction service provider.

Application No. 09/386,641
Group Art Unit: 3623

- 11 -

5. (original) The method of claim 4, wherein
said allowing comprises using data stored in a second field at said server,
and associated with said first service provider, to determine said interests
that are sanctioned by said first introduction service provider.
6. (original) The method of claim 5 wherein said allowing comprises
generating a database query, and querying a database of user records to
extract said selected ones of said second plurality of greetings.
7. (original) The method of claim 6 wherein said first field contains a binary
mask.
8. (original) The method of claim 7 wherein said second field contains a binary
mask.
9. (original) The method of claim 7, wherein said allowing comprises determining
service provider identifiers corresponding to said binary mask in said first
field.
10. (original) The method of claim 1, further comprising permitting a user of said
first service provider to send a message to said users associated with said
selected ones of said second plurality of greetings.
11. (original) The method of claim 10, further comprising levying a charge for
sending said message, and tallying a total of charges for users associated
with said first service provider.
12. (original) A message exchange system, comprising computer readable
memory storing,:

Application No. 09/386,641
Group Art Unit: 3623

- 12 -

a first plurality of greetings, each of said first plurality of greetings associated with users of a first introduction service;
a second plurality of greetings, each of said second plurality of greetings associated with a user of an introduction service, different from said first introduction service;
software allowing users associated with said first service provider, access to a selected one of said second plurality of greetings, based on criteria associated with an originator of said selected one of said second greetings, and criteria set by said first service provider.

13. (original) The system of claim 12, further comprising a database storing records associated with each of said users associated with said first service provider.
14. (original) The system of claim 13, wherein said software generates database queries, and queries said database to extract said selected ones of said second plurality of greetings.
15. (original) The system of claim 12, further comprising an interactive voice response ("IVR") unit, for obtaining instructions from said user by way of a telephone network.
16. (original) The system of claim 12, further comprising a network data interactive for obtaining instructions from said user by way of a data network.
17. (original) Computer readable medium, storing processor executable instructions, that when loaded at computerized message exchange system comprising a processor, adapt said computerized message exchange system to:

Application No. 09/386,641
Group Art Unit: 3623

- 13 -

store a first plurality of greetings at said system, each of said first plurality of greetings associated with users of a first introduction service provider;
store a second plurality of greetings at said server, each of said second plurality of greetings associated with a user of an introduction service provider, different from said first introduction service provider;
allow users associated with said first introduction service provider access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider.

18. (previously presented) The method of Claim 1, wherein said criteria comprise at least one of interest, age, and gender of said originator of each of said selected ones of said second greetings.
19. (previously presented) The system of Claim 12, wherein said criteria comprise at least one of interest, age, and gender of said originator of each of said selected ones of said second greetings.
20. (previously presented) The system of Claim 17, wherein said criteria comprise at least one of interest, age, and gender of said originator of each of said selected ones of said second greetings.